

III. REMARKS/ARGUMENTS

A. Generally

The Examiner has indicated that claims 1 - 2 are pending in the application; that claim 2 is rejected under 35 U.S.C. 112, second paragraph, as indefinite; that claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. US Patent 6,714,944; and that claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. in view of Backgrounds Online. Applicant, by this Amendment, has canceled original claims 1 - 2, and submits new claims 3 - 9, correcting the cited indefiniteness, and respectfully submitted to be both novel and unobvious in view of the prior art, alone or in combination.

B. Response to Rejections Based on 35 U.S.C. § 103(a)

The Examiner has indicated that claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. US Patent 6,714,944; and that claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. in view of Backgrounds Online.

Section 103(a) provides that "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made." 35 U.S.C. §103(a).

With respect to the rejection of former claim 2 (the subject matter of which is now submitted in new claims 7 and 8), a long line of cases stand for the proposition that when the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. *Heidelberger Druckmaschinen v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 30 U.S.P.Q.2d 1377, 1379 (C.A.F.C.1994); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931,934,15

U.S.P.Q.2d1321, 1323 (C.A.F.C.), cert. denied, 498 U.S. 920 (1990); *In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276,127 (C.A.F.C.1987). The mere fact that the prior art *may* be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783-84 (C.A.F.C. 1992); *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (C.A.F.C. 1984). The question is not whether what is claimed *could* have been done, but rather whether it was *obvious* to do so in light of all the relevant factors. *Arkie Lures Inc. v. Gene Larew Tackle Inc.*, 119 F.3d 953,957, 43 U.S.P.Q.2d 1294, 1297 (C.A.F.C.1997).

In order for the knowledge of persons of ordinary skill in the art to be sufficient to impart the motivation to combine references, the rejection must explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination of references. *Id.* Lacking a motivation to combine references, a proper *prima facie* case of obviousness is not shown. *Id.* A lofty level of skill alone does not suffice to supply a motivation to combine separate prior art disclosures. *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (C.A.F.C. 1998).

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50

USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.). [See MPEP § 2143.01]

To support the conclusion that a claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (P.T.O. Bd. Pat. App. & Int. 1985).

In the instant case, it is respectfully submitted that there is no suggestion or teaching in either Shapiro et al. or Backgrounds Online to incorporate verified criminal record history with a verified employee background report as claimed in new claims 7 and 8.

C. Current Claims

New claims 3 - 9 have been submitted to particularly point out the distinctions of the invention over the prior art, as discussed above.

IV. CONCLUSION

In view of these amendments and comments it is believed that each of the presently pending claims in this application is in condition for immediate allowance, and such allowance is therefore respectfully requested. The Examiner is invited to call Applicant's undersigned attorney if, in the opinion of the Examiner, a telephone conference will in any way expedite prosecution of this application.

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Respectfully Submitted,



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